

## **REMARKS/ARGUMENTS**

### **Response Period Extension; Declarations**

This response is accompanied by a petition for a three month extension of time along with the applicable extension fee, and by declarations of two independent experts in the relevant art, Ingrid Johnson ("Johnson Declaration") and John Callanan ("Callanan Declaration"), both of which are referred to herein.

### **Status of Claims**

Claims 1-31 are pending in this application, of which claims 1-15, 17-25 and 29-31 were rejected and claim 16 was objected as being dependent upon a rejected base claim. Claims 26-28 are allowed.

Claims 1, 15, 21, 23 and 29 are currently amended to clarify the invention recited therein. It is submitted that these amendments introduce no new matter to the application.

No claims have been canceled or added by this amendment, thus no extra claim fee is required.

### **Claim Rejections under 35 U.S.C. §102**

An anticipation rejection under §102 requires that a "...single prior art reference discloses, expressly or under principles of inherency, each and every element of [the] claimed

invention...” *RCA Corp. v. Applied Digital Data Systems, Inc. et al; Lear Siegler, Inc. v. RCA Corp.*, 221 USPQ 385 (Fed. Cir. 1984).

1. Claims 1 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,665,380 to Louis Ruffio (hereinafter “Ruffio”).

Claim 1 recites a stretch comb hair retainer comprising two opposed combs. Each comb has a spine defining the width of the comb and comb teeth projecting from the spine. A stretchable elastic mesh is secured between the spines of the two combs to produce tension between the combs. The elastic mesh has a width comparable to the width of the combs and is formed by elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open to allow an amount of the wearer’s hair can be pulled through individual openings.

The examiner states that Ruffio discloses stretchable openings through which an amount of the wearer’s hair can be pulled. Applicant disagrees. The Ruffio discloses that a woman’s headdress has an “elastic material such as elastic woven fabric” attached between two combs with tufts of hair attached to the front surface of the woven fabric material on “each side of the mid-section” of the fabric. (Ruffio, page 1, lines 58-77.) Although Ruffio discloses the woven fabric material to be “elastic,” this does not mean that the woven fabric of Ruffio provides for stretchable openings through which an amount of the wearer’s hair can be pulled, and particularly openings in a woven fabric that can individually be stretched open to allow for such

pulling through of the hair. See accompanying Callanan and Johnson declarations, experts in the relevant art, opining that this claimed feature of applicant's invention is simply not disclosed or otherwise revealed by Ruffio.

First, it is noted that Ruffio discloses a woven fabric material such as a "course mesh or net like structure to render the device light in weight and to provide supplementary anchoring means for pinning the hair thereto when forming the coiffure." (Ruffio, page 1, lines 72-76.) Such characteristics are consistent with materials such as crinoline. Callanan Declaration, ¶ 6. Crinoline and similar materials, such as hair cloth, have a stretchy characteristic, but do not have a high degree of elasticity. Callanan Declaration, ¶ 6. Use of the term "elastic" in Ruffio does not mean that the openings in the mesh can be stretched to enlarge the openings, but rather that the mesh apparently has just enough "give" to allow it to form over the head. Callanan Declaration, ¶ 6. Indeed, as pointed out by both Callanan and Johnson, any attempt to stretch the small openings of the Ruffio mesh would likely create a tear in the material. Callanan Declaration, ¶ 7; Johnson Declaration, ¶ 6. At best, individual hairs could be threaded through the individual unstretched mesh openings, a process that would be a tedious and totally impractical, and that would likely damage the hair. Callanan Declaration, ¶ 7.

Another indication of the elastic material in Ruffio being incapable of being stretched to enlarge the openings in the material through which an amount of the wearer's hair can be pulled, is the fact that Ruffio discloses a "small buckle" and "loop member" to provide "means for permitting a wider range of head sizes." (Ruffio, page 2, lines 3-8.) (Callanan Declaration,

¶ 6.) It is apparent that the fabric material used in Ruffio does not even stretch enough to accommodate different head sizes.

Moreover, a high degree of stretchability would not be desirable for the elastic foundation material of Ruffio since the tufts of hair are secured directly to the surface of this material. Johnson Declaration, ¶ 5. If overstretched, the fabric material would tend to pull the base of hair tufts apart, possibly causing detachment or partial detachment of the hair tufts from the extender. Johnson Declaration, ¶ 5.

To clarify the nature of the stretchable elastic mesh secured between the spines of the combs of applicant's invention, claim 1 has been amended to recite that the elastic mesh is formed by elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open so that an amount of the wearer's hair can be pulled therethrough. As discussed above, Ruffio simply does not disclose, directly or inherently, this claimed feature of the invention.

For at least these reasons, claim 1 and the claims that depend therefrom, such as claim 6, are not anticipated by Ruffio.

### **Claim Rejections under 35 U.S.C. §103**

[The] [t]est of obviousness under 35 U.S.C. 103 is not whether [the] prior art device could be modified into something resembling applicant's structure, but whether, at [the] time [the] invention was made, it would have been obvious to [a] person of ordinary skill in art, given teachings of prior art, to make [the] invention; in considering prior art, prior patents are references only for what they **clearly disclose or suggest** and it is not proper to modify their structures in manner that is not suggested by prior art. *National Tractor Pullers Association*,

*Inc. v. Watkins*, 205 USPQ 892 (N.D. Ill. 1980). Bold emphasis added.  
Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, **teachings of references can be combined only if there is some suggestion or incentive to do so.** *In re Fritch*, 23 USPQ2d 1780, 1783, 1784 citing *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.Cir. 1984); *In re Gordon*, 733 F.2d 902, 221 USPQ 1127.

While the so-called TSM test is not the exclusive test for determining obviousness, it provides a helpful insight to the obviousness determination. *KSR International Co. v. Teleflex Inc. et. al.*, 82 U.S.P.Q. 2d 1385, 1389 (USSC 2007). In all cases, the examiner must provide a clear articulated reason why the combination is obvious. *KSR International Co., supra*, at 1396, citing *In re Khan*, 78 U.S.P.Q. 2d 1329, 1335 (Fed. Cir. 2006)("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")

1. Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio.

Claims 3 and 4 depend from independent claim 1. Claim 1 as amended recites a stretch comb hair retainer comprising, *inter alia*, elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open that so that an amount of the wearer's hair can be pulled therethrough. Claim 3 recites that the elastic

strands are secured at spaced intervals to the spines of the combs and claim 4 recites that the strands are interconnected and form an elastic mesh formed at least in part by generally triangular shaped stretchable openings.

As discussed above, Ruffio does not expressly disclose stretchable openings or give any indication that the disclosed woven fabric has the sort of elasticity that will provide stretchable openings that can individually be stretched open so that an amount of the wearer's hair can be pulled through the openings of Ruffio's elastic fabric material. Callanan and Johnson Declarations. Rather, Ruffio points to the use of a woven fabric having relatively minimal elasticity, for example, by requiring an adjustable buckle to accommodate different sized heads. Ruffio effectively teaches away from the use of elastic strands to form an elastic mesh with stretchable openings that can individually be stretched open to enlarge openings by teaching a mesh construction that would likely be damaged by any attempt to do so.

For at least these reasons, claim 1 and the claims that depend therefrom, such as claims 3 and 4, are patentable over Ruffio.

2. Claims 2, 5, 12-14, 21-22 and 29-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of Japan Patent No. 409299131 (hereinafter "JPN '131").

Claims 2, 5 and 12-14 depend from independent claim 1. As discussed above Ruffio fails to disclose a stretchable elastic mesh formed by elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open so that

an amount of the wearer's hair can be pulled there through the mesh openings.

With respect to claim 2, which necessarily discloses the limitations of claim 1 as well as looped wire teeth on the two opposing combs, the Examiner states:

It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the particular comb as taught by JP '131 into the hair retainer of Ruffio in order to provide flexibility to the teeth of the combs so that they can [be] easy to guide through the hair of the user. (Office Action, page 4.)

Applicant respectfully disagrees that such a combination is obvious. First, the combination of Ruffio and JP '131 would not arrive at the claimed invention because as explained, Ruffio fails to disclose elastic strands extending between the spines of two opposing combs so as to form stretchable openings that can individually be stretched open to allow an amount of the wearer's hair to be pulled through the resulting substantial enlargement of openings. Furthermore, one of ordinary skill in the art would not be motivated to use the teeth of the combs in JP '131 to hold the Ruffio headress in place because, as suggested by the Examiner, the teeth of the JP '131 comb provide "flexibility" and easy guidance through the hair. Use of teeth with such a flexible characteristic is counterintuitive when it comes to providing a comb construction that will hold up against the restoring force of a stretched comb assembly in the manner of the invention.

Applicant has discovered that wire combs can indeed advantageously be used in a stretch comb hair retainer as recited in claim 1, where in use the opposed combs are stretched apart and flipped over to face each other as they are inserted in the hair. Despite their relative flexibility, it is found the combs provide the staying power needed to keep the hair retainer of the invention in place.

Similarly, with respect to claim 5, again, Ruffio does not disclose use of a stretchable elastic mesh formed by elastic strands so as to form stretchable openings through which the wearer's hair can be pulled, much less the advantageous configuration of providing stretchable openings of at least two different sizes:

These different sized openings can be advantageously used to pull different amounts of wearer's hair through the stretch comb retainer. Again, this enhances the flexibility of the retainer both in creating different hair styles and in allowing the retainer to be used with different types of hair, such as thin or fine hair which is difficult to style. The smaller half-sized openings of the mesh along the spine of each comb provide the added benefit of comfortably accommodating the wearer's finger tips, thereby allowing the wearer to get a good grip on the combs without getting caught up in the elastic mesh.  
(Specification, page 9, lines 14-21.)

With respect to claims 12-14, which are to specific sizing ranges for the elastic mesh and combs, the Examiner relies on *In re Rose* to justify the rejection of the claims based upon change in size of a known component. *In re Rose*, 105 USPQ 237 (CCPA 1955). This rejection is unfounded because claims 12-14 depend from independent claim 1. Independent claim 1 recites stretchable openings through which an amount of the wearer's hair can be pulled, which as discussed above, is not disclosed or taught by Ruffio. Further, the recited size ranges for the elastic mesh and comb of the present invention are not the mere scaling of a known component, but recitation of the ranges Applicant has discovered provide optimal use, which is not disclosed by the cited references. *In re Rinehart*, 198 USPQ 143 (CCPA 1976).

Claims 21-22 and 29-31 recite elements previously discussed with respect to claim 1 and 12-14, such as the stretchable openings through which an amount of the wearer's hair can be



pulled and size ranges for the elastic mesh and comb. Claims 21-22 and 29-31 are patentable over Ruffio and JP '131 for at least the reasons set forth above with respect to claims 1 and 12-14.

3. Claims 7-9, 15 and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of U.S. Patent No. 1,564,079 to Lorbiecki (hereinafter "Lorbiecki").

Claims 7-9 depend from independent claim 1 and claim 24 depends from claim 23.

Independent claims 1, 15 and 23, as well as the claims that depend therefrom, are patentable over Ruffio for at least these reasons set forth above, which include the fact that Ruffio fails to disclose, teach, or suggest a hair retainer with elastic strands or mesh extending between the spines of two opposing combs so as to form stretchable openings which can individually be stretched open so that an amount of the wearer's hair can be pulled through the openings.

Lorbiecki discloses a common hair net with ornamenting elements (8) secured to the hair net by tying elements (9). Lorbiecki fails to disclose the use of elastic strand materials, and particularly fails to disclose a stretchable elastic mesh secured between opposed combs, as in applicant's invention, wherein the mesh is comprised of elastic strands that form stretchable openings through which an amount of the wearer's hair can be pulled. With respect to claim 7, Lorbiecki further fails to disclose the use of substantially clear elastic strands for producing such a stretchable opening mesh.

In short, it would not have been obvious for one of ordinary skill in the art at the time the invention was made to employ the ornamenting elements of Lorbiecki on strands forming a

stretchable openings through which an amount of the wearer's hair can be pulled as in claims 1, 15 and 23, as Ruffio does not disclose a stretchable mesh material exhibiting such a feature.

4. Claims 10-11, 17-19 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of Lorbiecki, and further in view of U.S. Patent No. 5,154,196 to Moffat (hereinafter "Moffat").

Claims 10-11, 17-19 and 25 all depend from claims which recite an elastic mesh formed by elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open so that an amount of the wearer's hair can be pulled therethrough. As discussed above, an elastic mesh with such stretchable openings is not disclosed by Ruffio nor is it taught by Lorbiecki.

Moffat simply discloses the beading of hair barrettes using non-elastic beading wire, and the use of additional beading wire and beads between the barrettes. The barrettes work independently of each other, and the beaded wires connected between the barrettes serve no function other than a decorative function. Moffat fails to disclose or teach the beading of an elastic mesh as in applicant's invention, wherein the mesh produces tension between opposed combs for retaining the combs in the hair while providing stretchable openings which can individually be stretched open to allow an amount of the wearer's hair can be pulled the openings.

5. Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of Lorbiecki, and further in view of JPN '131.

Claim 20 depends from independent claim 15 which is patentable over the combination of Ruffio and Lorbiecki, for the reasons presented above. Thus, one of ordinary skill in the art at the time the invention was made would not be motivated to combine JP '131 with Ruffio and Lorbiecki to arrive at Applicant's invention.

#### **Newly Submitted Art**

In a supplemental information disclosure statement accompanying this amendment and response, Applicant submits two product brochures of uncertain publication dates recently provided to applicant's attorney by a third party who is informed of the publication of this application. One product brochure, titled Evita Peroni, is dated "Summer 2003," that is, after the priority date of the present application (April 28, 2003). The other reference titled "Look of Love/Hairpieces, Braids, Accessories, and bearing a copyright notice containing a "1997" year date ("Look of Love brochure"), discloses a "chignon," which is a knot of fake hair worn at the back of a women's head. The scant disclosure of the Look of Love brochure makes reference to the chignon as having "a lightweight honeycomb design stretchable base."

Assuming it to be "prior art," the Look of Love brochure manifestly makes no reference to elastic strands or stretchable openings in the base. A honeycomb design for a chignon base can allow the base to stretch without the capability of stretching open the individual openings of the

honeycomb. A honeycomb base design such as shown in the Look of Love brochure would allow for stretch in one direction as the openings of the honeycomb pattern elongate in response to a stretching force. This would be analogous to stretching fabric such as hose, where the openings in the fabric become smaller and tighter as it is being stretched. See Johnson Declaration, ¶ 4.

In short, the Look of Love brochure does not disclose a elastic mesh formed by elastic strands extending between the spines of opposed combs so as to form stretchable openings which can individually be stretched open to allow an amount of the wearer's hair to be pulled through the mesh openings. Furthermore, it would be undesirable to provide for such stretchable openings in a honeycomb base of a chignon. Stretching of the honeycomb openings of such a base material would tend to pull apart the hair knot attached to the base.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests the withdrawal of all the claim rejections based upon 35 U.S.C. §102(b) and §103(a), and submits that the present application is in condition for allowance, a request for which is hereby respectfully made.

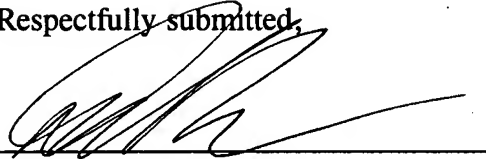
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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Donald L. Beeson', is written over a horizontal line.

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